



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/898,479	07/02/2001	Allan B. Lamkin	70681	8448

22242 7590 10/03/2006

FITCH EVEN TABIN AND FLANNERY
120 SOUTH LA SALLE STREET
SUITE 1600
CHICAGO, IL 60603-3406

EXAMINER

VU, NGOC K

ART UNIT PAPER NUMBER

2623

DATE MAILED: 10/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/898,479

Applicant(s)

LAMKIN ET AL.

Examiner

Ngoc K. Vu

Art Unit

2623

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 July 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8, 10-23 and 55-61 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8, 10-23 and 55-61 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a). Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

Response to Arguments

1. Applicant's arguments filed 7/20/06 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claims 56-61 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter as follows.

Claim 56 defines a computer readable medium embodying functional descriptive material. However, the claim does not define any structural and functional interrelationships between a computer program and other claimed elements of a computer which permit the computer program's functionality to be realized, and is thus non-statutory for that reason. Any amendment to the claim should be commensurate with its corresponding disclosure.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1-3, 6, 8, 10-23, and 55-61 are rejected under 35 U.S.C. 102(e) as being anticipated by Kanazawa et al. (U.S. 6,580,870 B1).

Regarding claim 1, Kanazawa teaches a method for providing enhanced content for play across multiple play platforms, comprising the steps of: delivering media content (via DVD) to a client device (e.g., personal computer, STB or image display apparatus) (col. 10, lines 59-63; col. 12, lines 19-23 and 45-47); delivering HTML content over a network (e.g., Internet) to a client device (e.g., personal computer, STB or image display apparatus), the HTML content being accessible and usable by a plurality of client device platforms (computer, STB) (col. 10, lines 59-61; col. 10, line 63 to col. 11, line 4; col. 11, lines 43-61; col. 15, lines 53-56); activating a browser to access the HTML content, the browser being located on and compatible for use with the client device (col. 15, lines 34-56; col. 11, lines 13-16); activating firmware on the client device to access the media content (col. 14, lines 13-65; col. 11, lines 11-16); and incorporating the accessed HTML content with the accessed media content (col. 11, lines 13-16 and 55-61; col. 15, lines 34-45 and 57-61; col. 16, lines 15-41).

Regarding claim 2, Kanazawa teaches accessing content recorded onto a recording medium (e.g., DVD) by calling one of the plurality of directories, the directory being suitable for use with the platform of the client device (col. 16, lines 1-17; col. 12, line 43 to col. 13, line 24).

Regarding claim 3, Kanazawa teaches that the directories include HTML content (e.g., HTML files) (col. 11, lines 53-58; col. 16, lines 21-23).

Regarding claim 6, Kanazawa teaches that the directories contain platform specific code segments (30, 40b – see figure 4).

Regarding claim 8, Kanazawa teaches that additional HTML content is provided via a portable storage medium (col. 11, lines 25-34; col. 11, lines 55-61; col. 12, lines 43-46; col. 16, lines 18-24).

Regarding claim 10, Kanazawa teaches that the network is the Internet (col. 11, lines 55-61).

Art Unit: 2623

Regarding claim 11, Kanazawa teaches that the HTML content is overlaid onto the media content (see figures 10C, 11B, 19A-19B).

Regarding claim 12, Kanazawa teaches that the HTML content is in the form of textual script, which scrolls with the media content (see figures 10C, 11B, 19A-19B).

Regarding claim 13, Kanazawa teaches that the HTML scrolls synchronously with the media content and wherein selecting a portion of the script navigates the user to a corresponding location in the media content (col. 15, lines 34-64; col. 20, lines 20-23; col. 11, lines 48-55; col. 11, lines 25-39).

Regarding claim 14, Kanazawa teaches that the HTML content is in the form of an HTML page that starts a movie and checks for related Internet sites (col. 11, lines 48-61; col. 15, lines 50-61).

Regarding claim 15, Kanazawa teaches that the HTML content includes a page that links to a website (see figures 19A-19B).

Regarding claim 16, Kanazawa teaches accessing additional HTML content that comprises a plurality of HTML files for accommodating a plurality of platforms of client devices (e.g., computer, STB) (col. 12, lines 43-47; col. 10, lines 59-63).

Regarding claim 17, Kanazawa teaches a method for enhancing multimedia content, comprising the steps of: providing a recording medium (e.g., DVD); recording multimedia content onto the recording medium (AV information and other information are stored on DVD – see col. 10, line 63 to col. 11, line 11); retrieving HTML content from a network (Internet) (col. 10, lines 59-61; col. 10, line 63 to col. 11, line 4; col. 11, lines 43-61; col. 15, lines 53-56); integrating HTML content with the multimedia content; accessing the multimedia content and the HTML content (col. 11, lines 13-16 and 55-61; col. 15, lines 34-45 and 57-61; col. 16, lines 15-41), and playing multimedia content and the HTML content having been accessed (col. 11,

Art Unit: 2623

lines 48-61; col. 19, lines 32-45; figures 19A-B).

Regarding claim 18, Kanazawa teaches that additional HTML content is provided via a portable storage medium (col. 11, lines 25-34; col. 11, lines 55-61; col. 12, lines 43-46; col. 16, lines 18-24).

Regarding claim 19, Kanazawa teaches that the multimedia content is DVD content accessed by DVD firmware on a client device, and where the HTML content is stored locally on the client device (col. 10, line 63 to col. 11, line 16; col. 15, lines 46-48).

Regarding claim 20, Kanazawa teaches that the multimedia content is DVD content accessed by DVD firmware on a client device and wherein the HTML content is provided from a remote server via a network (Internet) (col. 10, line 63 to col. 11, line 16; col. 11, lines 55-61).

Regarding claim 21, Kanazawa teaches that the multimedia content is DVD content; the HTML content is a textual script of the DVD content; and selection of a portion of the textual script navigates the multimedia content to a corresponding location in the multimedia content (col. 10, line 63 to col. 11, line 16; col. 20, lines 3-17).

Regarding claim 22, Kanazawa teaches that the multimedia content is DVD content and wherein accessing the multimedia content activates the HTML content, linking the user to a server providing HTML content corresponding to the multimedia content (col. 10, line 63 to col. 11, line 16; col. 11, lines 48-61).

Regarding claim 23, Kanazawa teaches that the multimedia content or DVD content and HTML content are displayed simultaneously on the screen (see col. 15, lines 34-37).

Regarding claim 55, Kanazawa teaches that the DVD playback control program will store the position and state of the DVD video presently being reproduced and go into the pause state. When the WWW browser is closed or when the user has specified the start of playback,

Art Unit: 2623

or after a specific period of time has elapsed, the DVD playback control program restarts the playback of the DVD video (see col. 16, lines 25-38).

Claim 56 recites the similar limitations of claim 1, therefore, claim 56 is rejected for the same reasons as addressed with respect to claim 1 above.

Claims 57 and 59 recite the similar limitations of claim 2, therefore, claims 57 and 59 are rejected for the same reasons as addressed with respect to claim 2 above.

Claims 58 and 60 recite the similar limitations of claim 8, therefore, claim 58 is rejected for the same reasons as addressed with respect to claim 8 above.

Regarding claim 61, Kanazawa teaches that the computer readable medium is a DVD (col. 10, line 63 to col. 11, line 16; col. 12, lines 10-24 and 40-47).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 4, 5 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kanazawa et al. (U.S. 6,580,870 B1).

Regarding claim 4, Kanazawa does not explicitly teach that the directories contain JavaScript files. Official Notice is taken that language other than HTML script like Javascript is well known in the art. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Kanazawa by using Javascript in order to provide a solution that can be automatically supported on a wide variety of standard web browsers already in use today by majority of end users.

Regarding claim 5, Kanazawa does not explicitly teach that the directories comply with

ISO-9660 standards. Official Notice is taken that a medium such having file directories such as ISO-9660 standard file system for CD-ROM/DVD media is well known in the art. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Kanazawa by including ISO-9660 standard file system for media in order to effectively manage data file.

Regarding claim 7, Kanazawa does not explicitly teach that the directories support hybrid Windows/Macintosh discs, preserving resource forks for Macintosh operating systems. Official Notice is taken that providing DVD medium containing audiovisual content to be used at various systems such as Windows or Macintosh is well known in the art. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Kanazawa by providing DVD medium containing audiovisual content to be utilized at various systems such as Windows or Macintosh in order to accommodate users having different systems.

Conclusion

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

Art Unit: 2623

however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ngoc K. Vu whose telephone number is 571-272-7306. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John W. Miller can be reached on 571-272-7353. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Ngoc K. Vu
Primary Examiner
Art Unit 2623

October 2, 2006